

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAUNO RANTANEN, HANNU KORHONEN, MARKKU LUMMILA,
and TIMO LINTULA

Appeal No. 96-1214
Application No. 08/065,182¹

ON BRIEF

Before SOFOCLEOUS, DOWNEY, and KIMLIN, Administrative Patent Judges.

DOWNEY, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-19, all the claims pending in the application.

¹ Application for patent filed May 20, 1993.

The subject matter on appeal is directed to a coating device (claims 1-14) and methods for coating a size-press roll, paper or board (claims 15-19). The coating device comprises a large-diameter revolving coating bar supported in a cradle and abutted against a moving base having a tubular shape, a hollow interior, a diameter of at least of about 18 mm and grooves on the outer surface thereof. The coating bar is structured and arranged to meter the coating agent onto the moving base. Additionally, the device includes a coating agent chamber. The method comprises providing a large-diameter revolving coating bar with open grooves, arranging the bar in a coating device, supporting the bar in a cradle, loading the bar against a moving base and applying, spreading and smoothing a coating agent on the moving base.

Appellants argue the claims in three groupings: (1) claims 1-7, 15-17 and 19 ; (2) claims 8 and 18 and (3) claims 9-14. Claims 1, 8 and 9 are illustrative and read as follows:

1. A coating device for coating a size-press roll, paper, board or a surface of a moving object, comprising

a larger-diameter revolving coating bar resting against a moving base having a machine width, said coating bar extending substantially along the machine width and having a tubular shape, a hollow interior, a diameter of at least about 18 mm and grooves on an outer surface thereof, said grooves opening in a direction toward said moving base,

a cradle supporting said coating bar substantially over its entire length, and

means for applying a coating agent onto said moving base in advance of said coating bar in a running direction of said moving base,

said coating bar being structured and arranged to meter the coating agent onto said moving base.

8. The device of claim 1, wherein said grooves have a variable depth and/or spacing arrangement such that a desired loading profile is obtained.

9. A device for coating a size-press roll, paper, board or a surface of a moving object, comprising

a large-diameter revolving coating bar resting against a moving base having a machine width, said coating bar extending across the machine width and having a tubular shape, a hollow interior, a diameter of at least about 18 mm and grooves on an outer surface thereof, said grooves opening in a direction toward said moving base,

a cradle supporting said coating bar substantially over its entire length, and

means for applying a coating agent onto said moving base in advance of said coating bar in a running direction of said moving base, said coating bar being structured and arranged to meter the coating agent onto said moving base, said means comprising

a coating-agent chamber having a front wall, said coating-agent chamber being partially defined by said coating bar, said front wall and said moving base, the coating agent being fed into said coating-agent chamber under pressure.

The references relied upon by the examiner are:

Montgomery et al. (Montgomery)	2,676,563	Apr. 27, 1954
Rantanen ('396)	5,122,396	Jun. 16, 1992

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The references relied upon by Board are:

Meinander	4,889,073	Dec. 26, 1989
Rantanen ('497)	5,246,497	Sep. 21, 1993

Claims 1-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rantanen ('396) and Montgomery. We reverse the rejection of claims 8 and 18. We will affirm the rejection of claims 1-7, 9-17 and 19 for we agree with the examiner's conclusion that these claims would have been obvious within the meaning of 35 U.S.C.

§ 103. For evidence of obviousness we rely upon the teachings of Rantanen('396), Meinander and Rantanen ('497)². Since we have relied upon additional evidence, appellants are to consider the rejection of claims 1-7, 9-17 and 19 a new ground of rejection under 37 CFR § 1.196(b).

Claims 1-7, 9-17 and 19

Rantanen ('396) shows a coating device and method for coating a web with a coating material comprising (1) a revolving coating bar having a grooved outer surface resting against a moving base and structured and arranged to meter a coating agent onto the moving base; (2) a cradle support for the bar; and (3) means for applying a coating

² We find the teachings of Montgomery cumulative to those found in Meinander and Rantanen (497).

agent. Rantanen ('396) fails to show a large diameter (at least 18 mm), hollow tubular shaped coating bar.

Montgomery shows a coating device and method for coating a web with a coating material which comprises a revolving coating bar having a large diameter, i.e., from 1/8 inch up to several inches or more. (See column 7, lines 20, 61, 68-column 8, line 15).

The examiner recognizes that the cited prior art does not show the use of a hollow bar; however it is the examiner's position that without the showing of criticality of a hollow bar v. a solid bar, the prior art's solid bar would be equivalent to the claimed hollow bar.

Appellants' sole argument and focus is that even if the teachings of Rantanen ('396) and Montgomery were combined, they would fail to establish a *prima case* of obviousness since they fail to teach or suggest a revolving coating bar which has a hollow interior. We find that this application contains sufficient evidence to establish that the use of a hollow revolving coating bar is conventional in this art.

Appellants submitted an IDS statement on May 20, 1993(Paper No. 2). In that statement, appellants cite, inter alia, U.S. Patent Number 4,889,073 to Meinander and Finland patent, No. 911345, and indicate that this Finish patent corresponds to Serial No. 07/686,026. Serial No. 07/686,026 is now U.S. Patent No. 5,246,497 ('497) to Rantanen. On this record, appellants did not provide any statement of relevance as to these

references and did not cite these references in their specification even though on page 3 of their specification they refer to the use of large-diameter bars and Meinander, Rantanen ('396 and '497) and the instant application are all assigned to Valmet Paper Machinery, Inc. During prosecution of the application, the examiner initialed the PTO 1449 on October 14, 1993 indicating that he considered the above prior art. Accordingly, had the record in this appeal been properly developed by appellants and the examiner it would have been recognized that it is conventional in this art to employ large diameter revolving tubular coating bars in methods and devices for coating webs. (our emphasis) Specifically, note that Meinander teaches a revolving bar having a diameter preferably from 20 to 200 mm that can be tubular and e.g. filled with water (see column 3, lines 19-22) ; and Rantanen ('497) teaches a revolving coating bar having a diameter of at least 18 mm, and optimally from about 25 to about 80 mm, that can be tubular (see column 3, lines 29-37, column 4, lines 17-20, 46-48 and column 5, lines 44-48). Accordingly, contrary to appellants' position, one of ordinary skill in this art would have found it obvious to employ a large diameter, hollow tubular shaped coating bar of Rantanen ('497) or Meinander in the coating device and method of Rantanen ('396) with a reasonable expectation of success.

Claims 8 and 18

Claims 8 and 18 require that the grooves on the revolving coating bar have variable depths and spacing arrangements. The examiner urges that claims 8 and 18 “do not require that the spacing and depth is varied, they only require that a depth and spacing is chosen so as to achieve a desired loading profile.” We disagree. These claims specifically require that “grooves have a variable depth and/or spacing arrangement” (our emphasis). The examiner has the initial burden under 35 U.S.C.

§ 103 to establish a prima facie case of obviousness. In re Piasecki, 745 F.2d 1468, 1472-73, 223 USPQ 785, 788 (Fed. Cir. 1984). On this record, the examiner has provided no evidence within the prior art or our general knowledge that would have suggested to one of ordinary skill in this art the subject matter of these claims. Carella v. Starlight Archery Pro Line Co., 804 F.2d 135, 139, 231 USPQ 644, 647 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 301-302, 227 USPQ 657, 675 (Fed. Cir. 1985), cert. denied 475 U.S. 1017 (1986); In re Rinehart, 531 F.2d 1048, 1051-52, 189 USPQ 143, 147 (CCPA 1976). Accordingly, the examiner’s rejection of claims 8 and 18 is reversed.

In addition to affirming the examiner’s rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective

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Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides that “[a] new ground of rejection shall not be considered final for purposes of judicial review.”

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the

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affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART 37 CFR § 1.196(b)

MICHAEL SOFOCLEOUS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MARY F. DOWNEY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
EDWARD C. KIMLIN)	
Administrative Patent Judge)	

MFD/caw

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APJ DOWNEY

APJ KIMLIN

APJ SOFOCLEOUS

DECISION: AFFIRMED-IN-PART 196(b)

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s): _____

Prepared: September 15, 2000

Draft Final

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